

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-12. By this paper, the Applicant has added new claims 13-20 and amended claims 1-12 for clarification of certain features and to expedite allowance of the present application. These additions and amendments do not add any new matter. Upon entry of these amendments, claims 1-20 will be pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Applicant also stresses that the present amendments are not believed to narrow the scope of the present claims. Applicant respectfully notes that claim 1 and 5, which were rejected under 35 U.S.C. § 102(b) in view of the cited reference, include means-plus-function language, as set forth in 35 U.S.C. § 112, paragraph 6. As may be appreciated, with respect to 35 U.S.C. § 112, paragraph 6, an Examiner “may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” *In re Donaldson Co.*, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994); *see also* Manual of Patent Examining Procedure § 2181. In particular, the Applicant respectfully notes that the recited means of claims 1 and 5 refer to the non-random fiber configuration depicted in Fig. 2. The present amendments merely clarify the structure as originally disclosed and claimed using the recited means. Accordingly, the Applicant does not believe these amendments alter the scope of claims 1 and 5.

### **Amendments to the Specification**

As noted above, paragraph 22 of the specification is amended for clarification of certain features. This amended paragraph 22 does not contain any new subject matter. For example, the amended paragraph 22 includes subject matter as supported in the original Fig. 2 which depicts an alternating, non-random arrangement of optical fibers 210 and 220. The amended paragraph simply clarifies the relationship of the optical fibers 210 and 220.

**Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Examiner stated that claim 4 does not limit the scope of claim 1, the independent claim from which it depends. *See* Office Action, page 2. Although Applicant does not necessarily agree with the Examiner's assertion, Applicant amended claim 4 as set forth above. Therefore, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Claim Rejections under 35. U.S.C. § 102**

The Examiner rejected claims 1, 2, 4-6, 8, 9, 11, and 12 under 35 U.S.C. § 102(b) as anticipated by Vari et al. (U.S. Patent No. 5,701,902). Applicant respectfully submits that amended independent claims 1 and 5 recite features not disclosed in the cited reference.

***Legal Precedent and Guidelines***

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

***Claim Features of Independent Claims Omitted from Cited Reference***

Turning to the claims, the amended independent claims 1 and 5 recite, *inter alia*, “means for spatially homogenizing the electromagnetic energy transmitted from the first source with the electromagnetic energy transmitted from the second source *in a non-random configuration* to form a spatially-homogenized multi-source electromagnetic energy.” (Emphasis added).

The Vari reference does not teach or suggest a structure for spatially homogenizing the transmitted electromagnetic energy “*in a non-random configuration*,” as recited by independent claims 1 and 5 (emphasis added). In contrast, the cited reference discloses *random dispersion* of optical fiber bundles 48-54. See Vari et al., col. 5, lines 24-27. In view of these deficiencies, the cited reference cannot anticipate independent claims 1 and 5 and their dependent claims. Accordingly, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102.

**Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 3 and 7 under 35 U.S.C. § 103(a) as obvious over Vari et al. In addition, the Examiner rejected claim 10 under 35 U.S.C. § 103(a) as obvious over Vari et al. in view of Jeffcoat et al. (U.S. Patent No. 5,036,853). Applicant respectfully traverses these rejections.

***Legal Precedent and Guidelines***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also

a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

#### ***Claim Features Omitted from the Cited References***

Dependent claims 3 and 7 depend from allowable independent claim 1 and dependent claim 10 depends from allowable independent claim 5, as discussed above. As set forth above, the Vari reference does not disclose all of the limitations of independent claims 1 and 5. Specifically, the Vari reference does not teach or suggest a structure for spatially homogenizing the transmitted electromagnetic energy “in a non-random configuration,” as recited by independent claims 1 and 5. Moreover, the Jeffcoat reference fails to obviate the deficiencies of the primary reference. On the contrary, the Jeffcoat reference does not address the spatial arrangement of the bundled optical fibers in the probe 100. *See Jeffcoat et al.*, col. 4, lines 57-61. Accordingly, Applicant respectfully requests that the Examiner remove the foregoing rejections under 35 U.S.C. § 103.

#### **New Claims**

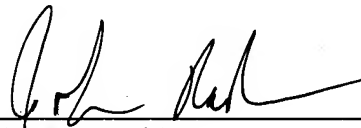
As set forth above, Applicant added new claims 13-20. For at least the reasons discussed in detail above, Applicant believes these claims are patentable over the cited references and in

condition for allowance. Therefore, Applicant requests that the Examiner allow the new claims 13-20.

**Conclusion**

In view of the remarks set forth above, Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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